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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,513	04/12/2004	William Ho Chang	1282-023/MMM	3266

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/823,513	CHANG ET AL.
	Examiner	Art Unit	
	Satish S. Rampuria	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the application filed on April 12, 2004.

2.   Claims 1-19 are pending.

Priority

3.   Acknowledgment is made of applicant's claim that no priority under 35

U.S.C. 119(a)-(d) has been claimed. Accordingly, the earliest priority date of the

invention is the US filing date **US Provisional Application** filed on April 11, 2003.

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C.

119(e), a specific reference to the prior-filed application in compliance with 37 CFR

1.78(a) must be included in the first sentence(s) of the specification following the title or

in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the

reference must include the relationship (i.e., continuation, divisional, or continuation-in-

part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C.

111(a) on or after November 29, 2000, the specific reference must be submitted during

the pendency of the application and within the later of four months from the actual filing

date of the application or sixteen months from the filing date of the prior application. If

the application is a utility or plant application which entered the national stage from an

international application filed on or after November 29, 2000, after compliance with 35

U.S.C. 371, the specific reference must be submitted during the pendency of the

application and within the later of four months from the date on which the national stage

commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the

prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not

extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or

120, where applicable, within this time period is considered a waiver of any benefit of

such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim

filed after the required time period may be accepted if it is accompanied by a grantable

petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120,

121 and 365(c). The petition must be accompanied by (1) the reference required by 35

U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless

previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that

the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5)

and the date the claim was filed was unintentional. The Director may require additional

information where there is a question whether the delay was unintentional. The petition

should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450,

Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time

period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or

an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference

was submitted in an oath or declaration or the application transmittal letter), and the

information concerning the benefit claim was recognized by the Office as shown by its

inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed August 3, 2005.

Specification

5. The disclosure is objected to because of the following informalities:

Appropriate correction is required.

6. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.

Drawings

7. The drawings were received on April 13, 2004. These drawings are acceptable by the examiner.

Claim Objections

Claims 1 and 17 are objected to because of the following.

8. Claim 1 objected to because of the following informalities: the word "computting" is misspelled.

9.   Claim 17 objected to because of the following informalities: the phrase "(may be moving to dependent claim)" appears to be a typo. Further, the period (.) is missing at the end of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11.   Claims 1, 2, 5-11, 13, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Publication No. 2003/0046447 to Kouperchliak et al. (hereinafter, Kouperchliak).

Per claim 1:

Kouperchliak discloses:

a controller for controlling interaction between the integrated circuit memory device and the host computing device (paragraph [0006] "...functional devices connectable to a computer host via an interface,...");

a memory component storing selected software operable on the host computing device (paragraph [0006] "...the computer host having a computer operating system comprising a mass storage device..."); and

autorun software stored on the integrated circuit memory device to load and run the

selected software on the host computing device automatically upon activation of the

integrated circuit memory device with the host computting device (paragraph [0006]

"...the computer host having a computer operating system comprising a mass storage

device driver with an autoplay feature operative, as long as an encountered device is

recognized as a mass storage device, to automatically port information contents of the

encountered device onto the operating system, the apparatus including a mass storage

device emulator operative, until it is deactivated, to cause the mass storage device

driver to recognize the selectable functional device as a mass storage device,...").

Per claim 2:

The rejection of claim 1 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 1 in which the autorun software is

embedded in the controller (paragraph [0022] "...a computer using an operating system

having an automatic installation procedure...").

Per claim 5:

The rejection of claim 1 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 1 further comprising a user operable

manual switch that allows a user to select from among plural operating states

(paragraph [0037] "...Within the memory is preferably stored a series of device-related

software items, each one appropriate to a different operating system or version...

provided one or more configuration files allowing the peripheral device to be configured

in different ways either selectable by the user or by the software").

Per claim 6:

The rejection of claim 5 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 5 in which the user operable manual

switch allows a user to select from among more than two operating states (paragraph

[0037] "...Within the memory is preferably stored a series of device-related software

items, each one appropriate to a different operating system or version... provided one

or more configuration files allowing the peripheral device to be configured in different

ways either selectable by the user or by the software").

Per claim 7:

The rejection of claim 1 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 1 with connections to plural distinct

peripherals (See FIG. 1 and related discussion).

Per claim 8:

The rejection of claim 1 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 1 further comprising a connection that is

connectable to a Universal Serial Bus port (paragraph [0006] "...load primary function

software which performs the primary function from the USB device onto the computer host").

Per claim 9:

The rejection of claim 1 is incorporated and further, Kouperchliak discloses:

The integrated circuit memory device of claim 1 in which the controller and the memory component operate together as a storage device to the host computing device (paragraph [0007] "...the mass storage device emulator residing on the functional device and being operative in conjunction with an operating system having a mass storage device driver with an autoplay feature...").

Per claim 10:

Kouperchliak discloses:

An integrated circuit memory device autorun method, comprising:

determining whether autorun software on an integrated circuit memory device is enabled upon activation of the integrated circuit memory device with a host computer (paragraph [0006] "...the computer host having a computer operating system comprising a mass storage device driver with an autoplay feature operative, as long as an encountered device is recognized as a mass storage device, to automatically port information contents of the encountered device onto the operating system, the apparatus including a mass storage device emulator operative, until it is deactivated, to

cause the mass storage device driver to recognize the selectable functional device as a mass storage device,....");

identifying enabled autorun software to the host computer with a device interface description (paragraph [0006] "...functional devices connectable to a computer host via an interface,....");

loading and running the autorun software on the host computer (paragraph [0006] "...the computer host having a computer operating system comprising a mass storage device driver with an autoplay feature operative,").

Per claim 11:

The rejection of claim 10 is incorporated and further, Kouperchliak discloses:

The method of claim 10 further comprising the autorun software re-enumerating itself to the host computing device as a different type of device and the integrated circuit memory device operating with the host computing device as the different type of device (paragraph [0006] "apparatus for automatic installation into a computer host, of a selectable functional device from among a population of functional devices connectable to a computer host via an interface, each functional device having a primary function, the computer host having a computer operating system comprising a mass storage device driver with an autoplay feature operative, as long as an encountered device is recognized as a mass storage device").

Per claim 13:

The rejection of claim 10 is incorporated and further, Kouperchliak discloses:

The method of claim 10 in which the device interface description identifies the

integrated circuit memory device in a manner analogous to that of a CD-ROM drive

(paragraph [0011] "...In one preferred embodiment the peripheral is operable as a Mass

Storage Device (hereinafter MSD) emulator which includes an AutoPlay feature

(hereinafler AX) which automatically starts a specific application on media upon

insertion Such a device can be a CD device using the AutoRun feature...").

Claims 16-18 are the computer product claim corresponding to system claims 1,

and 11 respectively, and rejected under the same rational set forth in connection

with the rejection of claims 1 and 11 above.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
are such that the subject matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

13.   Claims 3-4, 12, 14-15, and 19 rejected under 35 U.S.C. 103(a) as being

unpatentable over Kouperchliak in view of US Publication No. 2002/0145632 to

Shmueli et al. (hereinafter, Shmueli).

Per claims 3, 14, and 15:

The rejection of claim 1 is incorporated and further, Kouperchliak does not explicitly

discloses the integrated circuit memory device of claim 1 in which memory component

includes a protected memory component and selected software is stored in the

protected memory component and in which access to the selected software by the

autorun software requires authentication of the autorun software.

However, Shmueli discloses in an analogous computer system the integrated

circuit memory device of claim 1 in which memory component includes a protected

memory component and selected software is stored in the protected memory

component and in which access to the selected software by the autorun software

requires authentication of the autorun software (paragraph [0011] "...the software on

the portable device may provide an authentication routine instructing the host

computing device to receive authentication indicia from the user via an interface on the

host...determine if the authentication indicia received from the user matches

authentication indicia stored on the portable device...user must be authenticated...").

Therefore, it would have been obvious to a person of ordinary skill in the art

at the time the invention was made to incorporate the method of which memory

component includes a protected memory component and selected software is stored in

the protected memory component and in which access to the selected software by the

autorun software requires authentication of the autorun software as taught by Shmueli

into the method of automatic software/driver installation of a stored within the

device as taught by Kouperchliak. The modification would be obvious because of

one of ordinary skill in the art would be motivated to securely store the software in a protected area to provide privacy and security issues associated with computing on multiple computing devices on commercial and personal levels as suggested by Shmueli ((paragraph [0005]).

Per claims 4 and 12:

The rejection of claim 1 is incorporated and further, Kouperchliak does not explicitly discloses the integrated circuit memory device of claim 1 further comprising a wireless networking component and the selected software provides operation of the wireless networking component on the host computing device.

However, Shmueli discloses in an analogous computer system the integrated circuit memory device of claim 1 further comprising a wireless networking component and the selected software provides operation of the wireless networking component on the host computing device (paragraph [0033] "...smart card 10B may be a contact-based or a contactless (wireless) smart card 10B capable of interacting with the host 12...FIG. 2C depicts a wireless communication device 10C, such as a transponder, capable of facilitating wireless communications with the host 12...").

The feature of a wireless networking component and the selected software provides operation of the wireless networking component on the host computing device would be obvious for the reasons set forth in the rejection of claim 3.

Claims 19 is the computer product claim corresponding to system claim 3, and

rejected under the same rational set forth in connection with the rejection of claim

3, above.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to **Satish S. Rampuria** whose telephone number

is **(571) 272-3732**. The examiner can normally be reached on **8:30 am to 5:00 pm**

Monday to Friday except every other Friday and federal holidays. Any inquiry of a

general nature or relating to the status of this application should be directed to the

TC 2100 Group receptionist: 571-272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, **Wei Y. Zhen** can be reached on **(571) 272-3708**. The fax

phone number for the organization where this application or proceeding is assigned

is **571-273-8300.**

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satish S. Rampuria
Patent Examiner/Software Engineer
Art Unit 2191

WEI ZHEN
SUPERVISORY PATENT EXAMINER